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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/490,201 01/24/00 COLE

M 12059US02 *K.D.M.*

EXAMINER

MM91/0206

MCANDREWS HELD & MALLOY LTD  
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500 W MADISON STREET  
CHICAGO IL 60661

PATEL, D

ART UNIT

PAPER NUMBER

2831

DATE MAILED:

*#11*  
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*#8*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/490,201

Applicant(s)

COLE ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

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### **Part III DETAILED ACTION**

#### ***Claim Rejections - 35 U.S.C. § 112***

1. Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 5 and 8, "the preset" lacks antecedent basis. Examiner assumed "the preset housing".

In claim 1 lines 6 and 9, "the raceway panel" should be "said at least one raceway panel".

In claim 1 lines 8, "an after housing" is same as claim 1 line 1?.

In claim 6 line 3, "the raceway panel" should be "said at least one raceway panel".

In claim 6 line 5, "the raceway panels" lacks antecedent basis.

In claim 6 lines 5-6 and 8, "the raceway" should be "said at least one raceway panel".

In claim 6 line 14, "the adapter housings" lacks antecedent basis. Examiner assumed the housing.

In claim 11 line 2, "the raceway" lacks antecedent basis.

In claim 13 lines 7-8, "the raceway panel" lacks antecedent basis.

In claim 13 line 8, "the housing" lacks antecedent basis.

In claim 14 line 2, "the adapter clips" lacks antecedent basis.

In claim 15 line 4, "the raceway panel" lacks antecedent basis.

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In claim 19 line 6, " the raceway" lacks antecedent basis.

In claim 19 lines 8-9, " a preset" is a one of plurality of preset housings?.

In claim 19 line, " a second preset" is a one of plurality of preset housings?.

In claim 29 line 6, " the preset openings" lacks antecedent basis.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. § 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C: 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 6, 9-12 and 29 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Bartee et al (4,922,672) in view of L.J.Young (1,205,589).

Bartee et al disclose:

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Regarding claim 6, at least one raceway panel 12 embedded in a concrete floor, (see abstract lines 1-5), the raceway panel 12 an interior passage defined by a top wall, a bottom wall and a pair of side walls(see fig 2),a housing 10 adapted for connection to the top wall of the raceway (see fig1, column 4 lines 20-25), the housing having an interior compartment generally defined by a bottom wall and an upwardly extending sidewall (see fig1), the sidewall being adapted to receive an activation assembly (see fig 1) , the bottom wall including an aperture 32 adapted for alignment with an aperture 14 formed in the top wall of the raceway panel to provide access to services that carried by the raceway (see figs 1-2, column 3 lines 1-15). Bartee et al fails to disclose means for ganging at least two of the housings together to form integral assembly. L.J.Young teaches the use of means 14 knuckles (see column 2 lines 85-105) for the purpose of connecting several intermediate units side by side (see column 2 lines 107-110). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Bartee et al assembly with means (knuckles) for the purpose of connecting several intermediate units side by side as taught by L.J.Young. Regarding claim 9, the modified assembly of Bartee et al shows all of the claimed features but fails to disclose the preset housing being formed of metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified assembly of Bartee et al with the preset housing being made from a metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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Regarding claim 10, the preset housing is generally rectangular (see fig 1).

Regarding claim 11, the modified assembly of Bartee et al shows all of the claimed features including at least one locking tab 38-42 (see fig1, column 3 lines 25-30 of Bartee et al) adapted to secure the afterset to the top wall of the raceway panel.

Regarding claim 12, the modified assembly of Bartee et al shows all of the claimed features including a radial flange 34 (see column 3 lines 15-17 of Bartee et al) extending from the bottom wall of the housing and being configured for insertion into the opening in the top wall of the raceway (see figs 3-4).

Regarding claim 29, at least one raceway panel 12 adapted to be positioned in a concrete floor (see abstract lines 1-5), the raceway panel 12 defining an interior passage (see fig 4) adapted to carry service cables and having an exterior wall defining a preset opening 14 (see fig 2, column 3 lines 5-10) that provides access to the interior passage, a housing 10 (see fig 1, column 2 lines 65-68, and column 3 lines 1-5) mountable in the preset opening and to provide access to the interior passage of the raceway from an upper surface of the concrete floor. Bartee et al fails to disclose means for gaging at least two of the housings together to form integral assembly. L.J.Young teaches the use of means 14 knuckles (see column 2 lines 85-105) for the purpose of connecting several intermediate units side by side (see column 2 lines 107-110). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Bartee et al assembly with means (knuckles) for the purpose of connecting several intermediate units side by side as taught by L.J.Young.

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***Allowable Subject Matter***

3. Claims 1, 13 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.
4. Claims 2-5, 7-8, 14-18, 20-28 and 30 -31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter:  
  
For claims 1-5: an adapter connectable to the preset housing and being constructed to reconfiguring the preset housing for use as an afterset housing which is adapted for connection to the raceway panel following pouring of the concrete floor in combination with the other claim limitations.  
  
For claims 7-8: said ganging means comprises at least one alignment clip being adapted to slidably engage with a pair of adapter housings to form an integral assembly in combination with the other claim limitations.  
  
For claims 13-18: a plurality of alignment clip, each clip being adapted to secure two of the afterset housings to form an integral afterset assembly in combination with the other claim limitations.  
  
For claims 19-28: a plurality of alignment clip, each alignment clip being adapted to secure and align a preset carried by a first of the raceway panels with a second preset carried by a second of the raceway panels in combination with the other claim limitations.

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For claims 30-31: at least one adapter clip configured to slidably engage with a pair of preset housing to form an integral assembly in combination with the other claim limitations.

The above limitations are not taught or suggested by the prior art, or in combination.

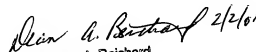
***Other prior art cited***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Handler et al, and Beele disclose a housing similar to applicant's claimed invention.

***Contact information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is (703) 308 -3748. The examiner can normally be reached on Mondays- Thursdays from 6:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid be reached at 703-308-0640. The fax number for this Group is 703-305-3431. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308- 0956.

Dhiru Patel  
Patent Examiner  
Group Art Unit 2831  
February 1, 2001

  
Jean A. Reichard  
Primary Examiner